

PATENT
DP-308792Remarks

Claims 1-6 are pending. Claims 1-4 have been rejected. Claims 5 and 6 have been objected to.

Claim 1 has been amended in the manner suggested by the Examiner to delete the language "of the type" and brackets. Claim 5 has been similarly amended at line 4 to delete brackets.

Claim 1 has been rejected under 35 U.S.C. § 102(b) over Yoji et al. (JP 2002/0023322). Claims 2-4 have been rejected under 35 U.S.C. § 103(a) over Yoji et al. in view of Duval et al. (U.S. Pat. No. 6,367,840). Applicants also respectfully request reconsideration of these rejections.

Rejection Under §102(b):

The Examiner contends that Yoji et al. discloses housing 3 having a longitudinal axis, a support member 10 that is supported by housing 3 for rotary movement about a shift axis, and a shift lever 20 operatively connected to support member 10 and extending radially from the shift axis for shifting movement in a limited space to forcibly rotate support member 10 about the shift axis. Applicants disagree and submit, with reference to Fig. 7 of Yoji et al., that housing 3 has rigidly fixed to it, as by welding, column mounting bracket 4 (which one of ordinary skill in the art would immediately recognize as being bolted through capsules to the vehicle structure) and bracket 5 to which support member 10 is bolted with bolts 13.

Referring to Fig. 8 of Yoji et al., the shift axis is that axis through support member 10 about which double-headed arrow B is encircled. Rear end portion 20a of shift lever 20 (Fig. 4 of Yoji et al.) extends through support member 10 and rotates in the directions of arrow B about the shift axis. Support member 10 is not supported by housing 3 for rotary movement about a shift axis. Rather, housing 3 and support member 10 are rigidly fixed together, neither rotating, with the shift axis extending through support member 10. Rear end 20a of shift lever 20 is rotatably disposed within support member 10 and does itself rotate about a shift axis, but shift lever 20 does not forcibly rotate support member 10 about the shift axis.

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"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference." Verdegaal Brothers, Inc. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Yoji et al. fails to disclose a housing having a longitudinal axis, a support member supported by the housing for rotary movement about a shift axis, and a shift lever operatively connected to the support member and extending radially from the shift axis for shifting movement in a limited space to forcibly rotate the support member about the shift axis, as called for in claim 1.

Applicants submit that because "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration[.]" W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554 (Fed. Cir. 1983) (citing Soundsciber Corp. v. U.S., 360 F.2d 954, 960, 148 U.S.P.Q. 298, 301, adopted, 149 U.S.P.Q. 640 (Ct.Cl. 1966)), the rejection of claim 1 under § 102 over the disclosure of Yoji et al. is improper, and respectfully request that the rejection be withdrawn.

Rejections Under §103(a):

Applicants further submit that modifying the structure taught by Yoji et al. such that its support member 10 (which is rigidly fixed to housing 3) is made to be forcibly rotated by shift lever 20 about the shift axis would destroy the intent, purpose and function of the column assembly disclosed by this reference. The general rule is that a §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the *prima facie* case of obviousness cannot properly be made. In other words, where there is no technological motivation for engaging in the modification and instead a disincentive, the rejection is improper. In re Gordon, 733 F.2d 900, 902, U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Therefore, in addition to claim 1 not being anticipated by Yoji et al., Applicants submit that claim 1 may not properly be rendered obvious over this reference.

"Dependent claims are nonobvious under §§ 103 if the independent claims from which they depend are nonobvious." Harness Int'l, Inc. v. Simplimatic Eng'g Co., 819 F.2d 1100, 1108 2 U.S.P.Q.2d 1826, 1831 (Fed. Cir. 1987). Because claim 1 may not be obvious over Yoji et al., Applicants submit that claims 2-4, rejected under 35 U.S.C. §

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103(a) over Yoji et al. in view of Duval et al. (U.S. Pat. No. 6,367,840) is also improper, and respectfully request that these rejections likewise be withdrawn.

Claim Objections:

For the above reasons, Applicants submit that the rejection of any claim from which claims 5 and 6 depend is improper, and that all rejected claims are now in condition for allowance. So, therefore, are claims 5 and 6.

Applicants respectfully submit that the present application is now in condition for allowance, and request that all rejections of, and objections to, the pending claims (as amended above) now be withdrawn and their allowance be granted.

In the event that Applicants have overlooked the need for an extension of time, payment of additional fee, or payment of additional amount of fee, Applicants hereby petition therefor and authorize that any charges be made to Deposit Account No. 50-0831, Delphi Technologies, Inc.

The Examiner is respectfully invited to telephone the undersigned at (248) 813-1250 should there be any questions regarding any of the above.

Respectfully submitted,



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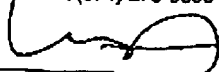
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CERTIFICATE OF FACSIMILE TRANSMISSION

The undersigned hereby certifies that this document is being facsimile transmitted to the United States Patent and Trademark Office at (571) 273-8300 on the date shown below.



Michael D. Smith

February 27, 2006

Date